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U.S. Application No.: 10/508,836
Inventors: Massimo BRUSAROSCO et al.
Attorney Docket No.: 05999.0189
Reply to Office Action mailed May 3, 2007

REMARKS

By this Reply, Applicants have amended claims 38-40, 45-52, 63, 64, 66, 68, 70, and 71. No new matter has been added. Claims 38-74 are pending on the merits.

I. Restriction Requirement

In the Office Action, the Examiner required an election under 35 U.S.C. § 121 of one of the following two groups of claims:

Group I, claims 38-50 and 71-74, allegedly directed to "a method for monitoring a tyre during running"; and

Group II, claims 51-67 and 68-70, allegedly directed to "a tyre or a wheel on a vehicle."

Office Action at 3-4.

Applicants provisionally elect Group I, claims 38-50 and 71-74, without traverse.

II. Claim Rejection under 35 U.S.C. § 112, Second Paragraph

Claims 38-40, 43, 51, 63, 66, 68, 69, 71, and 72 were rejected under 35 U.S.C. § 112, second paragraph. Although Applicants do not necessarily agree with the claim rejection under § 112, second paragraph, Applicants have amended claims 38-40, 45-52, 63, 64, 66, 68, 70, and 71 in order to expedite prosecution of this application.

The rejection statement asserts that with respect to claims 38, 40, 45-49, 63, and 64, the recitation of "at least one" prior to "second curve," "second group of sensors," and "third group of sensors" "is confused because it gives a thought of the existence of another "second curve," "second group of sensors," and "third group of

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sensors," respectively. Applicants respectfully disagree with the rejection statement's assertion that the recitation of "at least one" renders the claims indefinite, but Applicants have made the following claim amendments:

- "at least one second curve" has been changed to "a second curve";
- "the at least one second curve" has been changed to "the second curve";
- "at least one third curve" has been changed to "a third curve";
- "the at least one third curve" has been changed to "the third curve";
- "at least one first group of sensors" has been changed to "a first group of sensors";
- "the at least one first group of sensors" has been changed to "the first group of sensors";
- "at least one second acceleration sensor" has been changed to "a second acceleration sensor";
- "the at least one second acceleration sensor" has been changed to "the second acceleration sensor";
- "at least one third acceleration sensor" has been changed to "a third acceleration sensor";
- "the at least one third acceleration sensor" has been changed to "the third acceleration sensor";
- "at least one second group of sensors" has been changed to "a second group of sensors";
- "the at least one second group of sensors" has been changed to "the second group of sensors";

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"at least one third group of sensors" has been changed to "a third group of sensors"; and

"the at least one third group of sensors" has been changed to "the third group of sensors."

Applicants do not believe that these amendments change the scope of the claims at least because the claims recite the open-ended transition term "comprising." Thus, the claims implicitly recite the presence of "at least one" of each elements recited in the claims. The claims should be interpreted accordingly.

In light of the above-outlined claim amendments, Applicants respectfully request reconsideration and withdrawal of the portions of the claim rejection under § 112, second paragraph, relating to the recitation of "at least one."

Concerning the remaining portions of the claim rejection under § 112, second paragraph, the rejection statement asserts that claims 38, 39, 43, 51-52, 55, 66, 68, and 71 are indefinite "because the spec[ification] provides no definite limitation for the claimed word 'substantially' . . . ; [and] substantially is a relative term." Office Action at 2. Applicants respectfully traverse this portion of the claim rejection under § 112, second paragraph, because the scope of the claims is be clear to a person possessing ordinary skill in the art, and further, because although "substantially" may be a "relative term," being a "relative term" does not necessarily render "substantially" indefinite.

According to the guidance of the M.P.E.P., the issue of whether a claim particularly points out and distinctly defines the metes and bounds of the subject matter recited is determined under § 112, second paragraph, based on "whether the scope of the claim is clear to a hypothetical person possessing the ordinary level of skill in the

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pertinent art." § 2171. Furthermore, the M.P.E.P. advises that "[d]efiniteness of claim language must be analyzed, not in a vacuum, but in light of:

(A) The content of the particular application disclosure;

(B) The teachings of the prior art; and

(C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made. § 2173.01. Moreover, "[t]he fact that claim language, including terms of degree, may not be precise, does not automatically render the claim indefinite under 35 U.S.C. [§] 112, second paragraph." § 2173.05(b) (citation omitted). In fact, the use of the term "substantially" has been deemed definite in numerous court decisions. See § 2173.05(b)(D) (citing cases holding that "substantially" is definite under 35 U.S.C. § 112, second paragraph, even when the specification does not provide an express definition of the term) (citations omitted).

Applicants respectfully submit that a person having ordinary skill in the art would understand the metes and bounds "substantially on a same meridian plane of the tyre," as recited in claim 38, and "substantially on an equatorial plane of the tyre," as recited in claim 43. For at least the above-outlined reasons, Applicants respectfully submit that "substantially," as recited in Applicants claims, is not indefinite, and Applicants respectfully request reconsideration and withdrawal of this portion of the claim rejection under § 112, second paragraph.

Concerning the portion of the claim rejection under § 112, second paragraph, relating to claims 65, 69, and 72, those claims were rejected under § 112, second paragraph, because the recitations of "an elaboration unit," as recited in claims 65

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and 69, and the recitation of "a critical condition" and "a counteraction," as recited in claim 72, are allegedly indefinite. Office Action at 2-3. Applicants respectfully traverse these portions of the claim rejection under § 112, second paragraph, at least because a person having ordinary skill in the art would understand the metes and bounds of these recitations.

Concerning the rejection of claims 65 and 69, the Examiner asserts that "an elaboration unit" is "vague," and further, that "everything . . . can be considered as an elaboration unit" Id. at 2. Applicants respectfully disagree and respectfully submit that the M.P.E.P. advises that "[a] fundamental principle contained in 35 U.S.C. [§] 112, second paragraph is that applicants are their own lexicographers," and further that "[t]hey can define in the claims what they regard as their invention essentially in whatever terms they choose so long as any special meaning assigned to a term is clearly set forth in the specification." § 2173.01. Moreover, the M.P.E.P. advises that "[b]readth of a claim is not to be equated with indefiniteness" under § 112, second paragraph, and further, that "[i]f the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. [§] 112, second paragraph." § 2173.04 (citations omitted).

Applicants respectfully submit that recitations of "an elaboration unit" in claims 65 and 69 are definite under the guidelines provided by the M.P.E.P., at least because a person having ordinary skill art, in view of the specification and the prior art, would understand the scope of claim 65 and 69. Further, the scope of the recitations in claim 72 of "a critical condition" and "a counteraction," when interpreted in light of the

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remainder of the application and the prior art, would be understood by a person having ordinary skill in the art. For at least these reasons, Applicants respectfully submit that claims 65, 69, and 72 are definite under 35 U.S.C. § 112, second paragraph. Accordingly, Applicants respectfully request reconsideration and withdrawal of these portions of the claim rejection under § 112, second paragraph.

III. Conclusion

For at least the reasons outlined above, the claim rejection under 35 U.S.C. § 112, second paragraph, should be withdrawn, and claims 38-74 should be allowable. Since no objections or other claim rejections have been made, Applicants' respectfully submit that the claims are in condition for allowance. Moreover, Applicants respectfully request that if the Examiner issues another Office Action, including a claim rejection based on prior art, that the Examiner designate the Office Action non-final, since it would be improper to designate such an Office Action final at least because Applicants will not have been provided with a fair opportunity to respond to a claim rejection based on prior art.

Applicants respectfully request reconsideration of this application, withdrawal of the claim rejection, and allowance of claims 38-74.

If the Examiner believes that a telephone conversation might advance prosecution of this application, the Examiner is cordially invited to call Applicants' undersigned attorney at (404) 653-6559.

Applicants respectfully submit that the Office Action contains a number of assertions concerning the claims. Regardless of whether those assertions are

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addressed specifically herein, Applicants respectfully decline to automatically subscribe to them.

Please grant any extensions of time required to enter this Reply and charge any additional required fees to our Deposit Account 06-0916.

Respectfully submitted,

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Dated: August 3, 2007

By: 

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